

Notice of Allowability

Application No.

10/824,232

Examiner

Charanjit S. Aulakh

Applicant(s)

GERSTER ET AL.

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to _____.
 2. ☒ The allowed claim(s) is/are 22 and 23.
 3. ☐ The drawings filed on _____ are accepted by the Examiner.
 4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 10/19/04.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

DETAILED ACTION

1. According to a preliminary amendment, the applicants have amended claims 21-26.
2. Claims 21-26 are now pending in the application.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 21, drawn to compounds of formula of claim 21, classified in class 546, subclass 64.
 - II. Claims 22 and 23, drawn to compounds of formulae of claims 22 and 23, classified in class 546, subclass 82.
 - III. Claim 24, drawn to compounds of formula of claim 24, classified in class 546, subclass 79.
 - IV. Claim 25, drawn to compounds of formula of claim 25, classified in class 548, subclass 250.
 - V. Claim 26, drawn to compounds of formula of claim 26, classified in class 546, subclass 113.
4. The inventions I through V as defined above are patentably distinct, each from the other since they are structurally so divergent that a reference showing compounds of group I would not render compounds of groups II through V prima facie obvious. Search required for e.g ; compounds of group I in class 546, subclass 64 is not the same search required for e.g ; compounds of group II in class 546, subclass 82 and therefore, constitutes a burdensome search.

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5. During a telephone conversation with the applicants attorney, Mr. Dean A. Ersfeld on Oct. 19, 2004, a provisional election was made with traverse to prosecute the invention of group II, claims 22 and 23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21 and 24-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

EXAMINER'S AMENDMENT

7. The following amendment is pursuant to a telephone conversation with the applicant's attorney, Mr. Dean A. Ersfeld on Oct. 19, 2004. The following changes have been made in claims.

Cancel claims 21 and 24-26 directed to non-elected inventions without prejudice to the filing of a divisional application.

REASONS FOR ALLOWANCE

8. The following is an examiner's statement of reasons for allowance:

Claims 22 and 23, renumbered as claims 1 and 2, are allowed since the instant compounds are neither disclosed nor obvious over the prior art. In the art, Mickelson (

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U.S. Patent.6,638,944) discloses Imidazonaphthridines. The intermediate compounds 2 and 3 (see column 17, lines 20-50) disclosed by Mickelson do anticipate the instant compounds. However, this reference dos not constitute a prior art reference since it is inventor's own work and furthermore, the effective filing date is identical and to the same provisional application 60/069,276.

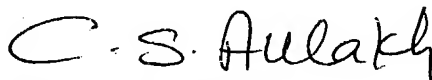
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is (571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571)272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charanjit S. Aulakh
Primary Examiner
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